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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/212,833	12/16/1998	DANIEL E. LEWIS	TELNP0163US	7815

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 05/19/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/212,833

**Applicant(s)**

LEWIS, DANIEL E.

**Examiner**

Edwin C. Holloway, III

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2-23-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24,26-33,35-45 and 47-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8,16,24,41 and 50 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,17,18,20-23,26-33,35-40,42-45,47-49 and 51-55 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Examiner's Response***

1. In response to applicant's amendment filed 2-23-04, the examiner has considered the claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-7, 9-15, 17-18, 20-23, 26-33, 35-40, 42-45, 47-49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cromer (US 6177860) in combination with Cowan (US 5846064). Cromer disclose a method and apparatus for tracking computers including transceiver (NIC in col. 14 line 40), processor (col. 2 line 62), passive tag (RFID 411), non volatile memory (EEPROM 111) and interface (130/140). Configuration information received by the RFID from an external source (interrogator) is stored in the memory for controlling network configuration and software download. See col. 2 line 55 - col. 4 line 22. Network configuration information is included in cols. 13-14 corresponding to a network interface controller (NIC) which is considered to represent a transceiver, but a wireless transceiver is not disclosed. Cowan discloses an

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analogous art configurable computer system with a wireless adaptor or NIC for software download. Figs. 2 and 6 include a wireless network adaptor transceiver configured according to conventional network adaptor transceiver techniques, processor, memory and input devices, but lacks passive tag. See col. 9 lines 39-55 It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Cromer a wireless NIC with wireless transceiver in view of the wireless adaptor with wireless transceiver in Cowan to allow wireless network communication with advantages such as wireless software download.

4. Claims 1-7, 9-15, 17-18, 20-23, 26-33, 35-40, 42-45, 47-49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cromer (US 6177860) in combination with Johnston (US 6064649). Cromer disclose a method and apparatus for tracking computers including transceiver (NIC in col. 14 line 40), processor (col. 2 line 62), passive tag (RFID 411), non volatile memory (EEPROM 111) and interface (130/140). Configuration information received by the RFID from an external source (interrogator) is stored in the memory for controlling network configuration and software download. See col. 2 line 55 - col. 4 line 22. Network configuration information is included in cols. 13-14 corresponding to a network interface controller

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(NIC) which is considered to represent a transceiver, but a wireless transceiver is not disclosed. Johnston discloses an analogous art configurable computer system with a configurable wireless adaptor or NIC with configuration data over a suitable interface such as PCMCIA to allow wireless network communication. See col. 8 lines 47-61. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Cromer a wireless NIC with wireless transceiver in view of the wireless NIC with wireless transceiver/modem in Johnston to allow wireless network communication because Johnston refers to a suitable interface for configuration of the wireless NIC and the RFID of Cromer is a suitable interface for entering configuration information.

5. Claims 1-7, 9-15, 17-18, 20-23, 26-33, 35-40, 42-45, 47-49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cromer (US 6177860) in combination with Cowan (US 5846064) or Johnston (US 6064649) as applied above and further in view of Cato (US 5539394). Cato discloses an analogous art tag system with wireless programming of initial identify and product data of the tag by a programmer through the tag antenna. See col. 4 line 6 - col. 7 line 19 and fig. 5. If programming of initial information by wireless communication is not clear in the combinations applied above then it would have

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been obvious in view of Cato disclosing wireless programming of initial identify or program of the tag by a programmer through the tag antenna. This allows programming that is not complex and uses techniques known in radio communication and computing.

***Allowable Subject Matter***

6. Applicant's argument that the prior art lacks the limitations in claims 8, 16, 19, 24, 41 and 50 that the wireless communication device being non-operational during receipt of the initial configuration information by virtue of being unassembled is persuasive.

7. Claims 8, 16, 24, 41 and 50 are allowed.

8. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 2-23-04 have been fully considered but are not persuasive. Applicant argues that wireless configuration would not have been obvious in Cromer because Cromer teaches against this by disclosing a wired plug to input configuration information and stating an antenna for wireless communication of configuration information is expensive. This argument is not persuasive because Cromer

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discloses in col. 1 line 49 col. 2 line 6 that an RFID chip with antenna to wirelessly download configuration information is known in Ser. No. 08/971386. Although this may be expensive, it is still disclosed as prior art by Cromer. The MPEP states:

2123 Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments

PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of

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flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.)

Although Cromer discloses the antenna to be costly, the patent does not disclose that the RFID with antenna would not work, and therefore it does not teach away from wireless communication to RFID. Further, Cowan discloses in col. 1 line 65 - col. 2 line 33 that ~~both~~ wired connection for configuration such as updating software has disadvantages such as requiring service technicians to make connections. This results in down time and related service costs. Therefore, one of ordinary skill in the art would readily recognize that both wired and wireless connection have costs, but either one would work.

#### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated



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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### CONTACT INFORMATION


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (703) 305-4700 or TC 2600 Customer Service at (703) 306-0377.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH  
5/15/04

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
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